UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 7

FISH & RICHARDSON, P.C.
4350 LA JOLLA VILLAGE DRIVE, SUITE 500
SAN DIEGO, CA 92122

In re Application of :
Phillips et al. :
Application No. 09/779,659 :
Filed: February 9, 2001 :
Attorney Docket No. 10064-002002 :

ON PETITION

This is a decision on the petition under 37 CFR 1.181, filed September 18, 2002, to withdraw the holding of abandonment. This is also a petition under 37 CFR 1.137(a), to revive the above-identified application.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137."

This application became abandoned for failure to reply timely to the Notice to File Corrected Application Papers mailed on March 8, 2001. The Notice set a two-month extendable period to submit substitute drawings in compliance with 37 CFR 1.84. No extensions of time were obtained pursuant to 37 CFR 1.136(a). Accordingly, this application became abandoned on May 9, 2001. A Notice of Abandonment was mailed on August 26, 2002.

Under 37 CFR 1.181:

Petitioner asserted that the delay was caused by nonreceipt of the Notice to File Corrected Application Papers (Notice) of March 8, 2001. A review of the written record indicates no irregularity in the mailing of the Notice, and in the absence of any irregularity there is a strong presumption that the Notice was properly mailed to the petitioner at the address of record as of March 8, 2001. This presumption may be overcome by a verified showing that the Notice was not in fact received.

The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file

jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. See Withdrawing the Holding of Abandonment When Office Actions Are Not Received; 1156 Off. Gaz. Pat. Office 53 (November 16, 1993).

In the present petition, petitioner failed to submit a statement from the practitioner attesting to the fact that a search of the file jacket and docket records indicated that the Notice to File Corrected Application Papers was not received. Moreover, petitioner failed to provide sufficient documentary evidence such as a copy of the docket records to support the allegation of nonreceipt of the Notice of March 8, 2001.

Accordingly, the petition under 37 CFR 1.181 is **dismissed.**

Under 37 CFR 1.137(a):

As previously stated petitioner asserts that the delay in prosecution was caused by nonreceipt of the Notice to File Corrected Application Papers mailed on March 8, 2001. Further, the attorney of record states that he first became aware of the abandonment on September 5, 2002, upon receipt of the Notice of Abandonment.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;

(2) the petition fee as set forth in § 1.17(l);

(3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and,

(4) any terminal disclaimer (and fee as set forth in § 1.20(d))required pursuant to paragraph (c) of this section.

This petition lacks item (3) above.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

> The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

A review of the written record indicates that the Notice to File Corrected Application Papers was properly mailed to the address of record as it existed on March 8, 2001. Furthermore, the Office notes that petitioner did not file a change of correspondence address with the United States Patent and Trademark Office until April 30, 2001.

The belated notification to the Office of the change of correspondence address does not constitute proper notification as to establish unavoidable delay. Petitioner is responsible for promptly notifying the Office of any change of address. The Office further notes that where an application becomes abandoned as a consequence of a change of correspondence address an adequate showing of "unavoidable" delay requires a showing that petitioner exercised due care to promptly notify the Office of the change of address and file a timely notification of the change of address in the application. MPEP 711.03(c)(III)(C)(2).

A delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an "unavoidable" delay. See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987),

Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

Accordingly, the petition under 37 CFR 1.137(a) is **dismissed.**

The Office acknowledges receipt of 8 sheets of substitute drawings on September 18, 2002. Petitioner may wish to consider filing a petition to revive under 37 CFR 1.137(b) for unintentional delay and submit the requisite fees.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, DC 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA

Telephone inquiries should be directed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy